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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,573	03/07/2002	Carl Joseph Kraenzel	042846-0312968	7969
52796	7590	07/21/2009		
PILLSBURY WINTHROP SHAW PITTMAN, LLP			EXAMINER	
c/o SUSAN TRADER			NGUYEN, TAN D	
1650 TYSONS BOULEVARD			ART UNIT	PAPER NUMBER
P.O. BOX 10500			3689	
MCLEAN, VA 22102				
		MAIL DATE	DELIVERY MODE	
		07/21/2009	PAPER	

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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARL JOSEPH KRAENZEL,
KATHERINE A. SPANBAUER and MARK A. NOWACKI

Appeal 2009-2793
Application 10/091,573
Technology Center 3600

Oral Hearing Held: June 23, 2009

Before MURRIEL E. CRAWFORD, ANTON W. FETTING
and JOSEPH A. FISCHETTI, Administrative Patent Judges.

ON BEHALF OF THE APPELLANT:

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The above-entitled matter came on for hearing on Tuesday, June 23, commencing at 1:29 p.m., at the U.S. Patent and Trademark Office, Dulany Street, Alexandria, Virginia, before Daniel Greenwald, Notary

1 MS. BOBO-ALLEN: Calendar No. 55. Appeal No. 2009-2793. Mr.
2 Gatto.

3 JUDGE CRAWFORD: Good morning.

4 MR. GATTO: Good morning.

5 JUDGE CRAWFORD: Oh, you're on both cases. Okay. I hadn't
6 noticed --

7 MR. GATTO: Yeah, I got a two for today.

8 JUDGE CRAWFORD: I hadn't noticed that before.

9 MR. GATTO: Yes, thank you.

10 JUDGE CRAWFORD: Okay.

11 MR. GATTO: I'll be very brief on the first one.

12 JUDGE CRAWFORD: All right.

13 MR. GATTO: I think it's clear in this case that the Examiner admits
14 that the recitations of enabling a user to declare and associate information
15 with one or more topics is not disclosed in the, in the prior art. The
16 Examiner admits that.

17 The issue, what it comes down to then is that the Examiner instead
18 tries to argue first that this is -- this may be inherently disclosed in the prior
19 art. If you look at the Examiner's Answer at page 9, to say that something
20 may inherently be disclosed is actual a legal oxymoron. As we know,
21 inherency means that the characteristic relied on in the prior art must
22 necessarily be present.

23 JUDGE CRAWFORD: Well, now, you know, looking at that
24 enabling clause, to me it looks like what this clause says is, and I think the
25 Examiner was saying this, is that it permits the user to enter in this data.

1 MR. GATTO: Right. Two things. First of all it does. If in the
2 context of this computer implemented invention you look at figure 4, for
3 example, there is a GUI presented to the user that enables a user to enter,
4 declare a topic and associate information. So yes, it does permit the user to
5 do that, and then the claim recites that you store the declared topic and the
6 associated information. So when you read the claim as a whole, it's clear
7 that there has to be a declaration that's stored in the system, and then you
8 further process that.

9 JUDGE CRAWFORD: Yeah, but the declaration is just entering
10 something in.

11 MR. GATTO: Well, it's entering a specific something in.

12 JUDGE CRAWFORD: Okay.

13 MR. GATTO: The claim specifically recites declaring a topic and
14 associating information, and the Examiner admits that that information is not
15 disclosed in the reference.

16 JUDGE CRAWFORD: But then he said that that's just printed
17 matter. I mean the -- what -- the information that's put in would not patently
18 distinguish it from the reference.

19 MR. GATTO: But storing specific -- the claim recites enabling the
20 user do, and it's a GUI that is what enables the user to do it. True, the user
21 enters information, and that information is stored. The claim specifically
22 recites that. So the fact that you're presenting a GUI and storing information
23 that's entered, that's not simply printed matter. That's how almost every
24 computer, you know, system has some aspect of user interaction, storing
25 information and then subsequent processing. So I think the Examiner's
26 argument regarding nonfunctional descriptive material, the Examiner

1 recognizes that these claimed elements are not in the prior art, and he tries to
2 do a bit of legal hand waving and say well, I'm not going to give any
3 patentable weight to this.
4 But I don't know how in the context of a computer method if you say that
5 you're enabling a user to do something by presenting a GUI and then storing
6 that information, right, that can't be just printed matter. There's just no legal
7 basis for that.
8 And as far as the specific information, what the Examiner alleges is that this
9 may inherently be disclosed in the prior art. And again, as I said, for
10 something to be inherent, it must necessarily be disclosed. You can't have
11 something that may be inherently disclosed.

12 JUDGE FISCHETTI: What is the connection between the content
13 and the process that you say is being driven by that content?

14 MR. GATTO: Well, again, I think if I understand the question
15 correctly, the first recitation by saying you're enabling a user to declare
16 topics and associate information, you're presenting a GUI to enable the user
17 to do that. And then the second step is storing the declared topics and
18 associated information so that there's a tangible tying of the entered
19 information into the system, and then there is the subsequent processing of
20 that information.

21 JUDGE FETTING: But given that it's just information that -- isn't
22 that the Examiner's point is fine, this -- the data entry and storage are
23 patentable steps. But data is data. It's just bits, and what those bits
24 represent is just non -- cannot define over the prior art.

25 MR. GATTO: Well, but I think part of the problem is the Examiner is
26 trying to improperly dissect the claim in saying okay, well, you have use of

1 information. But that's not what the claim says. I'm not saying just
2 enabling the user to enter any information. There is specific information, a
3 declared topic and associated information and that -- throughout the claim,
4 that specific type of information that the user enters and gets stored is then
5 processed for the particular purpose recited in the claim. So you can
6 monitor users' activities and determine if someone is interested in that
7 declared topic.

8 All right, and so again, I think it's another legal error that the
9 Examiner kind of truncates the claim element and say that, you know, this,
10 you know, there's information being entered. True -- that's true in almost --
11 in most computer systems. You're either entering information, processing
12 information, but if we were to analyze claims like that for purpose of
13 patentability, then you'd be ignoring specific recitations. If we just said
14 entering information, there may be more of an argument there, but it's
15 specific type of information for a specific purpose, and there's subsequent
16 claim elements that, that relate to that and tie back to that purpose and the
17 overall context of the invention.

18 JUDGE FETTING: But if you simply say storing a particular type of
19 information, and that's all there is to it then any -- then that particular type of
20 information is nonfunctional descriptive material. The -- it is a predictable
21 application of simply storing material. Unless you functionally rely upon
22 the nature of that data later on in the claim, it seems as though it's just
23 nonfunctional.

24 MR. GATTO: Well, again, I think if we take a step back, look at the
25 claim as a whole, okay, you can't focus just on the information. The claim
26 is a method, and it recites certain steps. Enabling the user to do something,

1 storing the result of what the user does, then determining if based on the
2 information stored if certain other activity meets that and then notifying. So
3 in a method claim you need to look at the steps.

4 Now I agree in connection with those steps there is information. But
5 to simply say that, you know, the claim is reciting information, therefore it's
6 printed material, is ignoring the fact that there's four method steps recited.

7 JUDGE FETTING: Okay, so let's get to the next steps then and see
8 how it all ties together.

9 MR. GATTO: Okay. So -- and again, I just to take one more step
10 back, I think one thing that's important in connection with the prior art, it's
11 clear that in the prior art it's a passive system as we argued. The user
12 doesn't declare anything. So in the prior art, if you're just monitoring user
13 activity, you may be notified of things you really don't care about, right.
14 You may be given a task about a topic you don't like and the system, they
15 say okay, well, you're associated with this task and send you information.

16 JUDGE CRAWFORD: I don't know that your claim has the user
17 declaring anything either.

18 MR. GATTO: The --

19 JUDGE CRAWFORD: You've got enabling a user to declare.

20 MR. GATTO: And then storing declared, past tense, topics, right.
21 When you read the claim as a whole, right, you know, we typically don't
22 recite a user performing a step, because under BMC and Union Auction
23 (phonetic sp.) it's hard to prove infringement. So if you enable -- if you
24 affirmatively enable a user to do it, in this case it's clear that's a GUI that
25 you're presenting, and then you store declared information, right, when you
26 read those two together, the user has to have declared something for you to

1 be able to store declared information, right. So I think that when you read
2 those together, right, it's pretty clear that they're presenting an option for a
3 user to do it via a GUI and then storing what's declared and associated.

4 JUDGE FISCHETTI: So you're inferentially saying by virtue of the
5 past tense use of declared that it was -- that the previous step basically was
6 occurred. Is that what you're saying?

7 MR. GATTO: It would -- a user would -- something would have to
8 be declared by the user for there -- for that to be stored, correct. But --

9 JUDGE FETTING: In the second step, where does it say that the
10 declared topics are in fact the same topics that were enabled to be declared
11 in the first step?

12 MR. GATTO: It recites storing declared topics. The -- two
13 comments there. I mean it's clear in the context of the claim as a whole
14 that's the only other recitation of declared topics is what's enabled but --

15 JUDGE FETTING: Could have been from outside of the scope of the
16 claim.

17 MR. GATTO: But even if that interpretation was adopted, there is
18 absolutely nothing in the prior art that's relied on where there's a declared
19 topic. You're simply monitoring user activities. There is no declaration of a
20 topic by the system or by the user in the prior art. So even if the claim were
21 interpreted that way, which is not how we think it should be interpreted, but
22 even if it was, the prior art still doesn't meet the claim elements.

23 JUDGE FETTING: So we're back to the nonfunctional description of
24 material characterization.

25 MR. GATTO: Right, which we believe is -- I mean again, there's
26 affirmative recitation of steps, including storing declared topics, that that's

1 not merely descriptive material. You're actually performing a computer
2 implemented step in connection with certain information.

3 JUDGE FETTING: You know, this nonfunctional printed material
4 came from *In re Ngai* which was printed instructions. Are you -- is your
5 position that if *In re Ngai* had been storing or reading back their instructions
6 from a computer rather than being on a printed piece of paper, it would have
7 come to a different conclusion?

8 MR. GATTO: Not necessarily. I mean if you're simply providing
9 instructions, that's one thing, but providing a GUI such as shown in figure 4
10 is not just instructions. I mean that is in the context of a computer
11 convention, if you're providing a GUI that enables you to do something or
12 providing a menu, right, that -- there's a functional component to that. It's
13 not just instructive material as the Examiner alleges. That's the error.

14 JUDGE FETTING: Okay, so again, it comes back to how you're
15 going to use this later on in the claim so --

16 MR. GATTO: In part, but I think that in and of itself, you know --

17 JUDGE FETTING: If all you're doing is storing the information, how
18 can the whatever information you're storing define over the prior art?

19 MR. GATTO: Because it's not just storing it, because you then
20 subsequently monitor the computer activities of a user and determine if a
21 user is interested in a declared topic. In other words, there's a set of specific
22 steps that use --

23 JUDGE FETTING: That's what I keep saying. Okay, let's see how
24 this is used later on.

25 MR. GATTO: Yes. Yeah, okay.

26 JUDGE FETTING: Okay.

1 MR. GATTO: So -- and I'm sorry. I thought I addressed that earlier,
2 but yeah, there are the subsequent steps of monitoring, determining and
3 notifying --

4 JUDGE CRAWFORD: But those are shown in the prior art.

5 MR. GATTO: But not with respect to the --

6 JUDGE CRAWFORD: With only difference being the data.

7 Whereas the prior art is monitoring I guess text proximate determinations,
8 and you're monitoring key words and topics.

9 MR. GATTO: Well, but again, it's monitoring a declared -- I mean a
10 declared topic, something that you declare you're interested in, okay. It's
11 not just a piece of information. There's -- it's not -- it's, you know, the
12 declaration applies an affirmative act. As we kind of argue, it's an active
13 system as opposed to a passive one in the prior art where there is no
14 declaration, there is no declared topic. Okay, and that -- in the context of the
15 invention, that presents a distinction over the prior art.

16 The -- there's not -- I mean the Examiner is not saying that you
17 can't -- I mean manipulating certain types, specific types of information,
18 right, the steps that you perform are not merely descriptive, right. And there
19 is no prohibition on -- I mean there's, there's a number of cases where, you
20 know, part of what makes an invention different in the context of a computer
21 invention is what type of information are you processing? What is the
22 information? This information, it's clear that it's declared topics and
23 associated information. All right, and so you're performing specific steps on
24 that, and that's what distinguishes over the prior art.

25 JUDGE CRAWFORD: What -- how do you respond to the Examiner
26 saying that the topic and the declared information that you're talking about

1 being topics and keywords is well-known -- are well-known parameters for
2 searching? So even if Tang doesn't disclose them, it would have been
3 obvious to modify it for keywords and --

4 MR. GATTO: Well, I think there's two arguments there. One, I
5 mean that -- even if that statement is true in and of itself, it's not relevant to
6 the 103 inquiry, because A, Tang doesn't disclose that. Tang is clearly a
7 passive system, and the Examiner acknowledges that, and there's no rational
8 underpinning for saying okay, because Tang is a passive system that we're
9 now going to convert it and say we'll have a declared topic in Tang. All
10 right, it's inconsistent with the teaching of Tang which is basically a passive
11 system --

12 JUDGE CRAWFORD: I'm kind of off the declared part of it. Just
13 let's talk about topic and keyword.

14 MR. GATTO: Well, then I think if you just look at topic then you're
15 not reading the claim element as a whole. It's a declared topic. We're not
16 saying just search a topic. Right, I will admit that searching topics in
17 general, right, may be known in the prior art, but that's not dispositive of any
18 issue with respect to obviousness. If we only recited searching a topic, then
19 that would be a relevant inquiry. But this talks about storing a declared topic
20 and then determining if the user is interested in the declared topic. You
21 cannot ignore the express recitations in the claim.

22 JUDGE CRAWFORD: I understand your point.

23 MR. GATTO: Unless you have any further questions, I have nothing
24 further on that.

25 JUDGE CRAWFORD: All right, on to the next one.

26 (Whereupon, the hearing concluded on June 23, 2009.)